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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/897,656	06/29/2001	Alan C. Berkema	10016784-1	9732

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HEWLETT-PACKARD COMPANY
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EXAMINER

POLTORAK, PIOTR

ART UNIT PAPER NUMBER

2134

DATE MAILED: 12/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	09/897,656		BERKEMA ET AL.	
	Examiner		Art Unit	
	Peter Poltorak		2134	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4,5,9-12,15,18-20,22,32-34 and 37-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4,5,9-12,15,18-20,22,32-34 and 37-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>8/1/06</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The Amendment, and remarks therein, received on 9/16/05 have been entered and carefully considered.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.

Response to Amendment

3. Applicant's arguments have been carefully considered but they were not found persuasive.
4. As per claim 15 applicant argues that the print capabilities as taught by Larsson don't meet the claim limitations because Larsson does not teach print capabilities as defined in the specification. Applicant states the examiner's interpretation is not consistent with the claim language and the specification, and supports the statement with the print capabilities definition: "information pertaining to the capabilities of the responsive print device". Furthermore, in an attempt to limit such a broad definition applicant offers examples pertaining to the definition.
5. Applicant's arguments have been carefully considered but they were not found persuasive.
6. The examiner points out that the printer in Larsson's invention does have the capability to receive, understand, generate and send a response information signal to a request (*col. 20 lines 25-32*) from a requesting device. This by itself reads on print capability.

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7. Furthermore, the examiner points applicant to pg. 13 lines 29-33 wherein Larsson explicitly teaches that the main task of the communication device 300a,b is to provide a cellular telephone with a printer specification.

8. Lastly, the examiner points out that the claim language limitation allows an even broader interpretation of the abbreviated definition cited in the specification, and examples are only examples and not definitions of terms.

Also, the examiner reminds applicant that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims.

9. As per claim 18 the subject matter that applicant argues is not clear and as a result the examiner addresses the two particular limitations recited by applicant: "a location at which a print content is located on a network" and "the locator identifying a location of print service".

10. For applicant's convenience in the current Office Action the examiner separated and mapped each of the limitations of claim 18 into Larson's reference. As it is clear from the reference a computer wirelessly communicates a reference to a print device that comprises a content location (*pg. 13 lines 11-15 and 33-35*) and the reference causes the print device to contact a print service (*pg. 13 lines 36-37*) that has the same location as the content (*pg. 16 lines 13-22*). Thus the reference identifies the location of the content as well as the print service location (*For a full discussion of claim 18 see the Office Action below*).

11. As per claims 37-39 applicant argues that a portable wireless device as taught by Larsson does not disclose separate interfaces for communication with a print device and a print service.
12. Applicant's argument has been carefully considered but it was not found persuasive.
13. The examiner points to Larsson (*e.g. Fig. 1*) who teaches a communication device (300) comprising a first communication interface adapted to enable LAN communication between the portable wireless device and a print service (60) and a second communication interface adapted to enable wireless communication implementing Bluetooth communication (*pg. 13 lines 25-29*) between the wireless device and a print device (380).
14. As per claims 4 and 20 applicant argues that billing information as taught by Saylor is not related to Larsson's invention and that Saylor does not provide any suggestion to send a reference wirelessly to a printer that includes billing information in the reference. Applicant questions motivation to combine arguing that the claims are more concerned with a pay for print service, as the print reference includes billing data.
15. Applicant's arguments have been carefully considered but they were not found persuasive.
16. The examiner points out that the main purpose of providing applicant with Saylor's reference was to accommodate the missing capabilities of Larsson's invention and not to duplicate them.

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17. As pointed out in the previous Office Action the missing element in Larsson's invention was adding billing information to a reference.
18. Applicant's argument that the combination is inappropriate was not found persuasive.
19. Saylor's reference clearly shows that information is a valuable commodity and as a result it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to add billing information to the reference as taught by Saylor et al. for the benefit of properly charging users for the accessed content (Saylor et al., col. 39 lines 44-49 and col. 27 lines 42-46).
20. As per claims 9-12 and 32-34 applicant argues that Takashi has nothing to do with printing by reference and is limited to a specific application of fingerprint security.
21. Applicant's arguments have been carefully considered but they were not found persuasive.
22. The examiner points out that the main purpose of presenting Takashi's reference was to accommodate the missing capabilities of Larsson's invention and not to duplicate them.
23. Also, the examiner points out that Takashi's reference was used to address "a security access code" and Takashi's teaching reads on the security access code.
24. Applicant repeats the argument that Takahashi's reference is irrelevant since "the user of a PDA is likely to keep the PDA on the person" and "the wireless device 100 in Larsson does not have the same security concerns that the personal computer of Takahashi does".

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25. The examiner points out to paragraph 21 in the previous Office Action wherein the very argument has already been addressed.

26. As per claims 11 and 34 applicant argues that "Yoon, in contrast to Larsson, provides a web info shop" and as a result "it is not all clear how Yoon's reference could be used to modify Larsson's system" and what this has to do with "the communication of a security code".

27. Applicant's arguments have been carefully considered but they were not found persuasive.

28. The examiner points out that "sending an authentication value" cited by Yoon reads on "the communication of a security code".

29. As far as applicant's concern about ability to modify Larsson's system to incorporate Yoon's teaching, the examiner points out that not only Yoon et al. discloses a technique wherein an authentication value is sent with a request (*Yoon, Abstract*) but also the implementation of authentication values is old and well known to one of ordinary skill in the art and the authentication values have been commonly used in a variety of computing environments (*e.g. logon process*) at the time of applicant's invention.

30. As per claims 19 and 22 applicant alleges that the used prior reference does not qualify as prior art and claims that the reference are hindsight reconstruction of the invention using the claims as a roadmap. Applicant argues billing and security issues, and to justify the position applicant asserts that supporting references have

nothing to do with Larssons' reference and that no artisan would have been motivated to implement such a combination.

31. Although these allegations have already been addressed above the examiner points out that it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper.
32. The examiner proved that the concepts claimed by applicant (although not present in Larssons' reference) are well known, recognized as important and used in the art of computing as illustrated by the supportive art. One of ordinary skill in the art would recognize that electronic content has real value. Similarly any commodities used in computer processes (e.g. printing paper) require financial investments. Thus, including billing and security into Larsson's invention would have been nothing less than obvious. For more complete discussion the examiner refers applicant to the discussion above.
33. As per claim 22 applicant argues that the presented motivation fails to conform with the language of the claim (which requires the computer to add information to the reference) and that the motivation is inappropriate.
34. Applicant's argument has been carefully considered but it was not found persuasive.
35. As per "adding information to the reference identifying a location at which a print content is located on the network" the examiner refers applicant to the discussion

regarding claim 18 (above), and as far as the “inappropriate motivation” the examiner points out that obviousness can be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

36. Applicant presents an additional argument in regard to claim 22 as rejected in view of Larsson and Bhogal. Specifically applicant states that the communication device 300 is defined as external, internal or “embedded” and not wireless.

37. Applicant's argument has been carefully considered but it was not found persuasive.

38. The examiner points to Larsson (*pg. 13 lines 25-29*) who teaches a communication device (300) communicating using Bluetooth.

39. As per arguments regarding claims 37-39 and presented on pages 19-20 the examiner refers applicant to the previous Office Action (§ 53) and points out that not only the communication device 300 comprises two interfaces (*pg. 13 lines 25-29*) but the telephone 100 (that applicant considered as the main portable device) also comprises two interfaces, one of which can be used to communicate with a print service (*e.g. pg. 12 and 13*).

40. Claims 4-5 9-12, 15, 18-20, 22, 32-34 and 37-39 have been examined.

Claim Rejections - 35 USC § 102

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41. Claims 5, 15, 18 are rejected under 35 U.S.C. 102(b) as being anticipated by

Larsson et al. (International Publication No. WO 0142894).

42. As per claims 5 and 18 Larsson teaches a communication device 300 that receives a document address from the cellular telephone 100 (*pg. 13 lines 33-35*).

This reads on: a computer wirelessly communicating a reference to a print device.

43. Larsson teaches that the communication device transmits the document address and the printer specification to an information service provider 200 (*pg. 13 lines 36-37*).

This reads on: "wherein the reference causes the print device to retrieve the print content from the network by causing the print device to supply the reference to the print service".

44. Larsson teaches that the information service provider is a server for serving the documents of a company (*pg. 13 lines 10-12*).

This reads on: "the print service adapted to retrieve the print content from the network".

45. Larsson teaches a print service device 210 that is a device that handles the request of a document to be printed and is implemented in the information service provider 200 (*pg. 13 lines 15-17*). Also, on page 16 Larsson further elaborates on the print service device referring to Fig. 5 that is provided with means 212 for receiving a request for a document to be printed (*pg. 16 lines 4-7*) and the document conversion means 218 that uses a portion of the printer specification containing data for

selecting an appropriate device driver 220 to convert the requested document to a printer file that the target printer can use (*pg. 17 lines 11-21*).

This reads on: "the print service adapted to format the retrieved print content for printing".

46. Larsson teaches that the print service device 210 is provided with means 212 for receiving a request for a document to be printed. The request comprises a document address, indicating where the document is situated (*pg. 16 lines 5-9*). The request is passed from the means 212 for receiving a request to a control means 214. The control means 214 then extracts the document address from the request and passes it on to a means for retrieving documents 216. The means for retrieving documents 216 then retrieves the document from the specified address within a memory 230 that the information provider has access to. The memory 230 is a storage memory of the information service provider (*pg. 16 lines 13-22*).

47. This reads on: the reference identifies "a location at which a print content is located on a network, and the location of a print service".

48. As per claim 15 *Larsson et al.* teach wirelessly communicating a discovery signal to a print device and receipt of a responsive signal identifying the print device within the reach of and compatible with the requesting device (*pg. 20 line 15- pg. 21 line 11*) and that the print device provides the requesting device with the printer's specification.

Claim Rejections - 35 USC § 103

49. Claims 4 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Larsson et al.* (International Publication No. WO 0142894) in view of *Saylor et al.* (U.S. Patent No. 6501832).

50. As per claims 4 and 20 *Larsson et al.* teach a print device communication device (300b) receiving a document address from the cellular telephone and transmitting the document address and the printer specification to the information service provider (pg. 13, lines 34-35), information service provider (200) which is a server for serving the documents and provides access to documents or other browsable information (pg. 13 lines 11-15), and a print service device (210) implemented in the information service provider and handling the request of a document to be printed (pg. 13 lines 15-22). Afterwards the retrieved document is sent to the target printer (pg. 17 lines 27-31).

Furthermore, *Larsson et al.* teach a communication device transmitting the document address and the printer specification to the information service provider. The printer specification comprises data regarding the transport route for a print file that is to be printed (pg. 13 line 35 - pg. 14 line 4).

51. *Larsson et al.* do not teach adding billing information to the reference.

52. *Saylor et al.* teach adding billing information to the reference (*Saylor et al.*, col. 31 lines 1-7).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to add billing information to the reference as taught by *Saylor et al.* for the

benefit of properly charging users for the accessed content (*Saylor et al.*, col. 39 lines 44-49 and col. 27 lines 42-46).

53. Claims 9-10, 12, 19 and 32-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Larsson et al.* (*International Publication No. WO 0142894*) in view of *Takahashi* (*U.S. Pub. No 20010016912*).

54. *Larsson et al.* teach the system as discussed above.

55. *Larsson et al.* do not explicitly teach that the computer interface communicates a security access code (*in response to a security challenge received from the print device*) to the print device enabling usage of the print device.

56. *Takahashi* teaches the computer interface communicating a security access code to a print device enabling usage of the print device [83].

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to communicate a security access code to the print device enabling usage of the print device as taught by *Takahashi*. One of ordinary skill in the art would have been motivated to perform such a modification in order to improve the print security function (*Takahashi*, [05]) and avoid waste printing (*Takahashi*, [2] and [84]-[86]).

Also, *Takahashi* teaches that the printing is not executed as long as a person with print authority is identified (*Takahashi* [83]) and as a result it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to implement a challenge from the print device if the request were provided without a security access code. One of ordinary skill in the art would have been motivated to

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perform such a modification in order to print content by providing an appropriate security access code.

57. Claims 11 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Larsson et al.* (International Publication No. WO 0142894) in view of *Takahashi* (U.S. Pub. No 20010016912) and in further view of *Yoon et al.* (U.S. Patent No. 6173407).

58. *Larsson et al.* in view of *Takahashi* teach the computer program product being sent to the printer causing the print device to access print content which is the Internet content as discussed above.

59. *Larsson et al.* in view of *Takahashi* do not explicitly teach the computer interface communicating a security access code to the print device enabling access to the print content.

60. *Yoon et al.* teach sending a security access code enabling access to the print content (*Internet content, Yoon et al., Abstract*).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to send access code enabling access to the print content as taught by *Yoon et al.* One of ordinary skill in the art would have been motivated to perform such a modification in order to allow access to fee-based content and determine the charges for the content usage (*Yoon et al., col.1 lines 45-60*).

61. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Larsson et al.* (International Publication No. WO 0142894) in view of *Ochiai* (U.S. Patent No. 6583886).

62. *Larsson et al.* teach a system as discussed above.

63. *Larsson et al.* do not teach a request and response for/to status information.

Ochiai teaches a request (and respond) for status information (col. 8 lines 6-16).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to communicate a request (and respond) for status information as taught by *Ochiai*. One of ordinary skill in the art would have been motivated to perform such a modification in order to be able to monitor the print job.

64. Claims 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Larsson et al.* (International Publication No. WO 0142894) in view of *Bhogal et al.* (U.S. Pub. 20030020944).

65. *Larsson et al.* teach the system as discussed above.

66. *Larsson et al.* do not teach a request and respond for/to status information.

Bhogal et al. teach a request and respond for/to status information [*Bhogal et al.*, 8].

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to add a request and respond for/to status information as taught by *Bhogal et al.* One of ordinary skill in the art would have been motivated to perform such a modification in order to be notified of a print job status [*Bhogal et al.*, 8].

67. Claims 37-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Larsson et al.* (International Publication No. WO 0142894).

68. As per claim 37 *Larsson et al.* teach a communication device (300) comprising a first communication interface adapted to enable wireless communication between the communication device and a print service (60) and a second communication

interface adapted to enable wireless communication between the wireless device and a print device (380). The communication device communicates a reference that identifies the location of a print service content to the print service, wherein communicating the reference to the print service causes the print service to retrieve the print content from a network and further causes the print service to transmit the print content to the wireless device (*Fig. 4, pg. 15 lines 29-32, pg. 13 lines 33- pg. 4 lines 4*).

69. *Larsson et al.* do not explicitly teach that the communication device is a portable communication device. However, is old and well-known practice to move about network computing devices and as a result it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to implement a wireless device in *Larsson et al.*'s invention as a portable wireless device. One of ordinary skill in the art would have been motivated to perform such a modification in order to be able to change the location of the wireless device.

70. As per claim 38 *Larsson et al.* teach providing the print service (print service device) with printer's specification (*col. 16 lines 7-9*) upon which the document is retrieved (*pg. 16 lines 13-20*) and converted using a portion of the printer specification containing data for selecting an appropriate device driver to determine what device driver to use for creating the print file (*pg. 17 lines 11-15*).

71. The limitations of claim 39 are implicit as Fig. 4 shows that the wireless device is connected to the printer 380.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


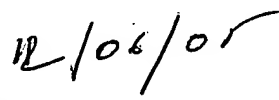

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Poltorak whose telephone number is (571)272-3840. The examiner can normally be reached Monday through Thursday from 9:00 a.m. to 4:00 p.m. and alternate Fridays from 9:00 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse can be reached on (571) 272-3838. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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